



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,374	12/21/2001	Eugeniy A. Lukhtanov	17682A-007310US	8027

20350 7590 07/12/2004

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

DENTZ, BERNARD I

ART UNIT	PAPER NUMBER
----------	--------------

1625

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/026,374

Applicant(s)

LUKHTANOV ET AL.

Examiner

Bernard Dentz

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-58 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

Art Unit: 1625

Election is required in this 371 Application between the following inventions which are not so linked as to form a single inventive concept under PCT Rule 13.1.

Gp. I, claims 1,3,4 and 10- drawn to a method of preparing a fluorescent dye-labeled biological agent by contacting a fluorescent dye fused lactone derivative with an unlabeled biological agent.

Gp. II, claims 2 and 5-9 drawn to a method of making a fluorescent dye-labeled phosphoramidite reagent comprising contacting the above lactone derivative with a linking group component and then contacting same with a compound containing a phosphoramidite moiety to attach the phosphoramidite moiety to said fluorescent dye-labeled linking group.

The following 4 Groups refer to the left side formula compounds of claim 39.

Gp. III, claims 39-41 drawn to fused lactones having 3 fused rings.

Gp. IV, claims 39-41 drawn to fused lactones having 4 fused rings.

Gp. V, claims 39-41 drawn to fused lactones having 5 fused rings.

Gp. VI, claim 39 drawn to fused ring lactones having 6 fused rings.

The following 4 Groups refer to the right side formula compounds of claim 39.

Gp. VII, claim 39 drawn to fused lactones having 3 rings.

Gp. VIII, claim 39 drawn to fused lactones having 4 rings.

Gp. IX, claim 39, drawn to fused lactones having 5 rings.

Gp. X, claim 39 drawn to fused lactones containing 6 rings.

The following 4 Groups refer to the left side formula of claim 42.

Gp. XI, claims 42-44 drawn to dye reagents having 2 fused rings.

Art Unit: 1625

Gp. XII, claims 42-52 drawn to dye reagents having 3 fused rings.

Gp. XIII, claims 42-46 drawn to dye reagents having 4 fused rings.

Gp. XIV, claims 42-44 drawn to dye reagents having 5 fused rings.

The following 4 Groups refer to the right side formula of claim 42.

Gp. XV, claims 42-44 drawn to dye reagents having 2 fused rings.

Gp. XVI, claims 42-45 drawn to dye reagents having 3 fused rings.

Gp. XVII, claims 42-45 drawn to dye reagents having 4 fused rings.

Gp. XVIII, claims 42-44 drawn to dye reagents having 5 fused rings.

Gp. XIX, claims 53-58 drawn to oligonucleotide probes containing a 5,6-dichlorofluorescein dye.

The inventions listed above don't relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2 they lack the same or corresponding special technical features for the following reasons: I and II represent different processes for labeling biological materials. In 1 case the fluorescent lactone and in the other the fluorescent dye labeled phosphoramidite is used as the labeling reagent. The Markush claim drawn to lactones is unpatentable over the prior art since a preliminary search in Chem. Abstracts showed several compounds anticipating the left side 3 fused ring lactones. Thus the presumption of unity of said Markush claim no longer exists. See PCT Administrative Instructions Annex B, page A1-36 and 37, Paragraph (f). The same reasoning holds for the dye reagents of Markush claim 42.

Art Unit: 1625

Of course each Markush claim is of enormous scope. Finally oligonucleotide probes of Group XIX use a 5,6-dichlorofluorescein dye outside of the scope of the dyes of the other method and compound claims.

Thus the above restriction requirement is proper. *Further in case no generic claim is found allowable election of a single disclosed species is required.*  
A telephone call was made to Mr. Kezar on 6-30-2004 to request an oral election

to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Dentz whose telephone number is 571-272-0683. The examiner can normally be reached on Mon-Fri from 8 to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Dentz  
7-7-2004

B. Dentz  
6